

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 78/143,801 for the mark MINI ME filed on July 15, 2002, and published on April 1, 2003.

NEW LINE PRODUCTIONS, INC.

Opposer

v.

Opp. No. \_\_\_\_\_

HARRY MARTIN FINE JEWELRY, INC.

Applicant



07-24-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

**NOTICE OF OPPOSITION**

New Line Productions, Inc. believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to the mark MINI ME for a variety of goods and services.

2. Since long prior to the acts complained of in this notice, Opposer has continuously used the MINI ME mark for various products and services.

3. Opposer has obtained the following registrations and filed the following application for its family of MINI ME marks in the Patent and Trademark Office:

- ☐ Reg. No. 2,418,334, MINI ME, for printed matter and paper goods-namely, books featuring characters from animated action adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, coloring books, children's activity books; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets, chalk and chalkboards; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party favors and paper party decorations-namely, paper napkins,

paper doilies, paper place mats, crepe paper, paper hats, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pajamas sweatshirts and t-shirts; paper photo frames, in International Class 16;

- Reg. No. 2,730,841 MINI ME, for toys and sporting goods, including games and playthings - namely, action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; equipment sold as a unit for playing card games; toy vehicles; dolls; flying discs; electronic hand-held game unit; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlor game and an action type target game; stand alone video output game machines; jigsaw and manipulative puzzles; paper face masks; skateboards; ice skates; water squirting toys; balls - namely, playground balls, soccer balls, baseballs, basketballs; baseball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; surfboards; swim boards for recreational use; swim fins; toy bake ware and toy cookware; toy banks; toy snow globes; and Christmas tree ornaments, in International Class 28; and
- Appln No. 78/122,984, MINI ME, for motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; prerecorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; hand-held calculators; audio cassette and CD players; CD rom games; hand-held karaoke players, telephone and/or radio pagers; short motion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; video cassette recorders and players, compact disc players, digital audio tape recorders and players, electronic diaries; radios; mouse pads; eyeglasses, sunglasses and cases therefore; booklets featuring comedy, drama, action, adventure, animation and music information sold with audio tapes, as a unit featuring comedy, drama, action adventure, animation and music information; computer programs, namely, software linking digitized video and audio media to a global computer information network; game equipment sold as a unit for playing a parlor-type computer game; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories; encoded magnetic cards, phone cards, credit cards, cash cards, debit cards and magnetic key cards; and decorative magnets, in International Class 9.

4. The mark MINI ME has been widely used and publicized for a period of many years, through association with the well known *Austin Powers* series of motion pictures.

5. Opposer owns all rights to the trademarks associated with said motion picture, including MINI ME.

6. Since the initial use of the mark, Opposer has made a substantial investment in

advertising and promoting its goods and services under the mark MINI ME through various channels of trade in commerce.

7. Opposer has built extensive goodwill in its MINI ME mark, as a result of the significant advertising and publicity. As a result, the mark has become well known and famous as a distinctive indicator of the origin of Opposer's goods and it symbolizes Opposer's valuable goodwill.

8. Since the first use of the MINI ME mark, Opposer and its related companies have distributed a wide variety of goods bearing the mark throughout the United States.

9. Opposer's MINI ME mark has been used on these goods by licensees, pursuant to agreements under which Opposer controls the nature and quality of the goods.

10. The MINI ME mark is derived from one of the most well known and visually distinctive characters in the highly popular *Austin Powers* series of movies. The character, a 2'8" high clone of DR. EVIL, is incapable of speech but very capable of biting.

11. The fame of the MINI ME mark has been enhanced by the fact that Verne Troyer, who portrays the MINI ME character, is a well known actor who has appeared in such motion pictures as *The Grinch Who Stole Christmas*, *Harry Potter and the Sorcerer's Stone*, *Instinct*, *Fear and Loathing in Las Vegas*, *My Giant*, *Mighty Joe Young*, *Jingle All the Way*, *Men in Black*, *Bubble Boy*, *Rocket Man*, *Wish Master*, *Baby's Day Out* and *Dunston Checks In*.

12. Although he has had an active career, Troyer he has become a cultural icon through his role as MINI ME.

13. Troyer also has achieved considerable notoriety through television appearances and the endorsement of products such as Apple computers. In connection with these products, he appeared in a television commercial, aired during and after the 2003 Super Bowl, with 7'6"

Houston Rockets basketball player Yao Ming.

14. Notwithstanding Opposer's prior rights in its mark, Applicant filed the above referenced application for registration of the mark MINI ME for figurines of precious metal in International Class 14.

15. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the date of first use alleged in its application.

16. Upon information and belief, Applicant knew or had reason to know of Opposer's MINI ME mark when Applicant filed its application.

17. Opposer has used its MINI ME mark continuously on or in connection with its good and services in interstate commerce since long prior to the filing date of Application No. 76/401,628.

#### **Likelihood of Confusion - §2(d)**

18. The mark which Applicant seeks to register is identical to or so resembles Opposer's names and marks that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark.

19. The goods and services of Applicant are so related to the goods and services sold under Opposer's mark, that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods and services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

20. Likelihood of confusion in this case is enhanced by the fame of Opposer's mark and by the fact that consumers associate them with goods sold, approved or endorsed by

Opposer; moreover, individuals using Applicant's goods are prospective purchasers of Opposer's products.

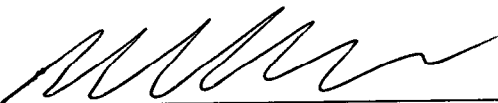
**Deception/False Suggestion of Connection - §2(a)**

21. Applicant's mark so closely resembles Opposer's mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods.

22. Applicant's alleged mark so closely resembles Opposer's mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that goods offered under Applicant's alleged mark are connected with Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

NEW LINE PRODUCTIONS, INC.

By 

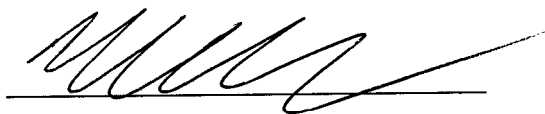
Michael A. Grow  
Arent Fox Kintner Plotkin & Kahn, PLLC  
1050 Connecticut Avenue, NW  
Washington, D.C. 20036  
(202) 857-6000

Attorney for Opposer

18/14/2003TT48

**CERTIFICATE OF MAILING**

It is hereby certified that the attached Notice of Opposition and check (re S/N 78/143,801) are being deposited with the U.S. Postal Service addressed to the Hon. Commissioner of Patents and Trademarks, Washington, DC 20231 this 23<sup>rd</sup> day of July 2003 marked first class mail, postage prepaid.

A handwritten signature in black ink, consisting of several stylized, overlapping loops and a long horizontal stroke at the end, positioned above a solid horizontal line.

08/14/2003 TAB



**Arent Fox Kintner Plotkin & Kahn, PLLC**  
1050 Connecticut Avenue, NW  
Washington, DC 20036-5339  
Phone 202/857-6000  
Fax 202/857-6395  
www.arentfox.com

July 23, 2003

**Eileen T. Henry**  
Senior Legal Assistant  
202/857-6174  
henrye@arentfox.com

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202



07-24-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

**Re: New Line Productions, Inc.  
-v- Harry Martin Fine Jewelry, Inc.  
Application No. 78/143,801 - MINI ME  
Our Ref: 19429-127**

Dear Sir:

Enclosed, in duplicate, is a notice of opposition pertaining to the above referenced application.

Also enclosed is our check in the amount of \$300 to cover the filing fee. Any additional fee which may be required should be charged to our deposit account No. 01-2300.

All correspondence pertaining to this petition should be sent to Opposer's counsel *Michael A. Grow at Arent Fox Kintner Plotkin & Kahn, PLLC, 1050 Connecticut Avenue, NW, Washington, DC 20036 (telephone: 202-857-6389).*

Sincerely,

Eileen T. Henry  
Senior Legal Assistant

Enclosures

72711\_1.DOC

Washington, DC

NEW YORK